

REMARKS

Claims 1-12 and 32 have been canceled. Claims 13-31 and 33-37 remain pending in this application. Claims 13, 14, 22, 23, 25, 28, 31, and 33 have been amended. Applicant amended claims 22, 23, 25, and 28 for formality. Applicant refers to pages 22 to 32 of the specification and Figs. 1-5 as illustrative embodiments and supporting material of the amendments to claims 13, 14, 31, and 33. No new matter has been added.

The Examiner rejected claims 13-37 under 35 U.S.C. §101 for allegedly being directed to non-statutory subject matter. However, 35 U.S.C. §101 provides that a patent may be obtained by any inventor of a new process, among other things. There is no requirement that the process require “technology”, as asserted in the Office Action. Furthermore, contrary to the assertion of the Office Action, the claimed invention provides a useful, concrete, and tangible result, namely, postal objects assembled into mail packages to achieve a specified return on investment. However, in the interest of expediting prosecution and/or to clarify the subject matter claimed, applicant has amended independent claims 13 and 31 to read “a postal object selecting method *in a mail packaging system...*” and “an object selecting method *in a packaging system...*” (emphasis added), respectively. Applicant refers to pages 22 to 32 of the specification for illustrative embodiments of the claimed methods (implementable by one skilled in the art of mail object packaging systems), and Figs. 1-5 for illustrative embodiments of the “packaging system,” recited in amended independent claims 13 and 31. Applicant, therefore, respectfully requests that the Examiner withdraw the §101 rejection of independent claims 13 and 31, and claims 14-30 and 33-37 dependent therefrom respectively.

The Examiner also rejected claims 13-37 under 35 U.S.C. §112, second paragraph, for allegedly indefinite language.

The Examiner listed the following terms as being allegedly indefinite: “determining an access charge for each object,” “gross profit from the customer,” and “return on investment.” In response, applicant amended independent claims 13 and 31 in a good faith effort to further clarify the steps recited therein. Applicant respectfully submits that these terms are well-defined in the specification and would be clearly understood by one skilled in the art. As such, the claimed invention is implementable by the skilled artisan by reading the illustrative embodiments disclosed in the specification. Applicant, therefore, respectfully submits that the independent claims 13 and 31 distinctly claim the subject matter of the invention and requests that the Examiner withdraw the §112, ¶2 rejection thereof.

Applicant has amended claims 23 and 28 to remove the language pointed out by the Examiner. Applicant is uncertain about which claim the Examiner was referring to, instead of claim 29, in the above Office Action with respect to the term “online,” because claim 29 does not include this term. Applicant assumes that the Examiner was referring to the inconsistent manner of reciting “online processing” in claim 25, and has amended claim 25 to be consistent with all other claims and the description of “online processing” in the specification.

Applicant, therefore, further requests that Examiner withdraw the §112, ¶2 rejection of claims 14-30 and 33-37 dependent from claims 13 and 31, respectively.

Claims 13-37 stand rejected under 35 U.S.C. §102(b) as being anticipated by Baggarly et al. (U.S. Patent No. 4,797,830). In response, applicant amended independent claims 13 and 31 in a good faith effort to further clarify the claimed invention as distinguished from the applied reference. The Examiner’s rejection is, therefore, respectfully traversed.

As amended, independent claim 13 recites, in part, “determining an access charge for each object by customer, said determining comprising the steps of: determining an expected

gross profit from the customer, determining a probability of success of the object with respect to the customer, and determining provisioning costs for the object; determining an expected return on investment from one or more of the plurality of customers for one or more of said plurality of objects based on the determined access charge; and selecting one or more objects to be assembled into a mail package for one of said plurality of customers, such that an expected return on investment from the customer for said mail package is substantially the same for each of the one or more of the plurality of customers.”

In rejecting claim 13, the Examiner relied upon column 1, lines 52-55 and column 2, lines 9-11 of Baggarly et al. The portions relied upon by the Examiner appear to describe a summary of the invention disclosed in Baggarly et al., which appears to be a mail packaging and weighing system. The system disclosed in Baggarly et al. provides for adding advertising inserts and determining the weight of a stuffed envelope so that a maximum number of inserts may be added without raising the postage requirement of an envelope. (see, e.g., col. 2, lines 8-27, col. 9 lines 35-56, Figs. 4A, 4B, 4C, 5A, 5B and their corresponding description in Baggarly et al.) The system described in Baggarly et al., as relied upon by the Examiner, does not appear to include any consideration for *the value of each insert* or any consideration of the *cost-benefit tradeoff* for including any particular insert. The particular reference in Baggarly et al. relied on by the Examiner to show “an expected return on investment” and related features only apparently discloses a machine which makes “an accurate determination of the weight of an envelope and its associated required inserts, results in a substantial financial savings.” (Baggarly et al.; col. 2, lines 9-11). This section of Baggarly et al. does not disclose or even suggest determining an expected return on investment from one or more of the plurality of customers for one or more of said plurality of objects based on a determined access charge.

Furthermore, claim 13 has been amended to recite that feature of “selecting one or more objects to be assembled into a mail package for one of said plurality of customers, such that an expected return on investment from the customer for said mail package is substantially the same for each of the plurality of customers.” Baggarly et al. does not disclose an object selecting method that includes this feature. Since Baggarly et al. does not suggest or disclose the recited features of claim 13, the reference does not anticipate claim 13.

Claim 31 includes features similar to those recited in claim 13, and is therefore allowable for at least the same reasons as claim 13 is allowable.

Thus, advantageously, the claimed invention provides an additional level to the system of selecting objects in a package, such that a mere postage increase would not automatically preclude an object from being included in a package so long as it is justified by a sufficient increase in expected return.

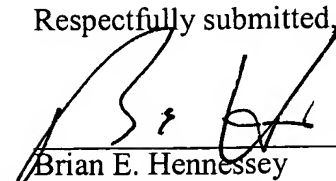
Applicant, therefore, respectfully submits that amended independent claims 13 and 31, together with claims 14-30 and 33-37 dependent therefrom respectively, are patentable over Baggarly et al.

The Examiner has made of record, but not applied, several U.S. patents, a U.S. patent publication, a European patent publication, and a non-patent publication. Applicant appreciates the Examiner’s implicit finding that these references, whether considered alone or in combination with others, do not render the claims of the present application unpatentable.

In view of the remarks set forth above, this application is in condition for allowance which action is respectfully requested. However, if for any reason the Examiner should consider this application not to be in condition for allowance, the Examiner is respectfully requested to telephone the undersigned attorney at the number listed below prior to issuing a further Action.

Any fee due with this paper may be charged to Deposit Account No. 50-1290.

Respectfully submitted,



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Docket No: 101353-00054 (ENRIGHT 21.016)

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